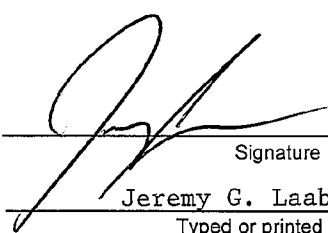


Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) S63.2-10812-US01						
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>	<table border="1" style="width: 100%; border-collapse: collapse;"><tr><td style="width: 50%; padding: 5px;">Application Number 10/790,941</td><td style="width: 50%; padding: 5px;">Filed 3/1/2004</td></tr><tr><td colspan="2" style="padding: 5px;">First Named Inventor Joseph Miller</td></tr><tr><td style="padding: 5px;">Art Unit 3726</td><td style="padding: 5px;">Examiner Jermie E. Cozart</td></tr></table>		Application Number 10/790,941	Filed 3/1/2004	First Named Inventor Joseph Miller		Art Unit 3726	Examiner Jermie E. Cozart
Application Number 10/790,941	Filed 3/1/2004							
First Named Inventor Joseph Miller								
Art Unit 3726	Examiner Jermie E. Cozart							
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <div style="display: flex; justify-content: space-between; align-items: flex-start; margin-top: 20px;"><div style="width: 45%;"><p>I am the</p><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>53170</u></p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p></div><div style="width: 50%; text-align: center;"> _____ Signature Jeremy G. Laabs _____ Typed or printed name 952-563-3000 _____ Telephone number October 18, 2007 _____ Date</div></div> <p style="font-size: small; margin-top: 20px;">NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>								
<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>								

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Miller and Scribner
Application No.:	10/790941
Filed:	March 1, 2004
For:	AUTOMATED MARKERBAND NEST PLACEMENT CRIMPER
Examiner:	Jermie Cozart
Group Art Unit:	3726

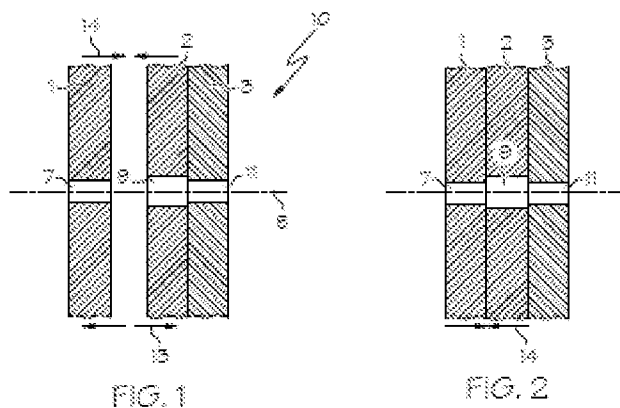
Docket No.: S63.2B-10812-US01

PRE-APPEAL BRIEF REQUEST FOR REVIEW

This Request is filed with a Notice of Appeal, in response to the Advisory Action dated **August 24, 2007**.

Claims 1, 2, 4, 5, 7-11, 20-22 and 24-27 stand rejected under 35 USC § 102 over Ching (US 6481262). Claims 6, 12 and 23 stand rejected under 35 USC § 103 over Ching.

Claim 1 recites a “first cylindrical member defining a longitudinal axis,” and requires a first plate to be “moveable...along the longitudinal axis.” Claim 20 similarly requires a first plate to be “moveable relative to the second plate along the length of the catheter.” Claim 21 requires a first plate and a second plate to be “moveable relative to one another to adjust a distance between the first nest and the second nest as measured along the length of the catheter.”



Applicants' Figures 1 and 2, provided above, show a plate 1 moving along the length/longitudinal axis 5 of a cylindrical member that would be placed in the claimed device.

FIG. 6

Movement Along Axis

The Examiner asserts that because the claim does not require the presence of a cylindrical member/catheter, he is not obligated to interpret the “longitudinal axis” recited in the claim as that of the cylindrical member/catheter. The Examiner appears to assert that because the Ching plate can be interpreted as defining its own “longitudinal axis,” and because the Ching plate can move along its “longitudinal axis,” the limitations of the pending claims have been met. See Final Office Action at page 5, and a similar assertion at pages 6-7; also comments in Advisory Action.

Claims are interpreted according to their plain meaning, and the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. See *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Claim 1 defines the claimed “longitudinal axis” as that of the “first cylindrical member.” Claim 1 further recites movement “along the longitudinal axis.” Thus, the recited movement is clearly defined as being along the previously defined longitudinal axis of the cylindrical member. Claim 20 similarly defines a “catheter” and requires the first plate to be moveable “along the length of the catheter.” Claim 21 similarly defines a “catheter” and requires the first plate to be moveable “to adjust a distance...as measured along the length of the catheter.”

The pending claims define a longitudinal axis/catheter, and then specifically define movement of a plate with respect to how the longitudinal axis /catheter is positioned in the device. Although the physical presence of a cylindrical member/catheter is not required, appropriate movement of the plates with respect to such a cylindrical member/catheter is required to meet the limitations of the pending claims. The plain meaning of the language recited in the claims precludes the reasoning asserted in the rejection.

Movement of the Ching plates, being perpendicular to the catheter axis, is clearly different from the movement recited in the pending claims. Therefore, Applicants assert that Ching does not disclose or suggest all of the limitations of independent claims 1, 20 and 21, and that these claims are patentable over Ching under 35 USC § 102. See also Response After Final filed 8/17/07 at pages 5-7.

Manipulation of Ching Device

The Advisory Action asserts that a person of skill in the art would be able to insert the Ching catheter 60 into the Ching device in a way that satisfies the pending claims, wherein a plate would move along the axis/length of the catheter 60. Applicants assert that if the catheter were inserted in such a way, the Ching device would not be able to crimp the stent to the catheter. Thus, the proposed manipulation would render the Ching device unsuitable for its intended purpose.

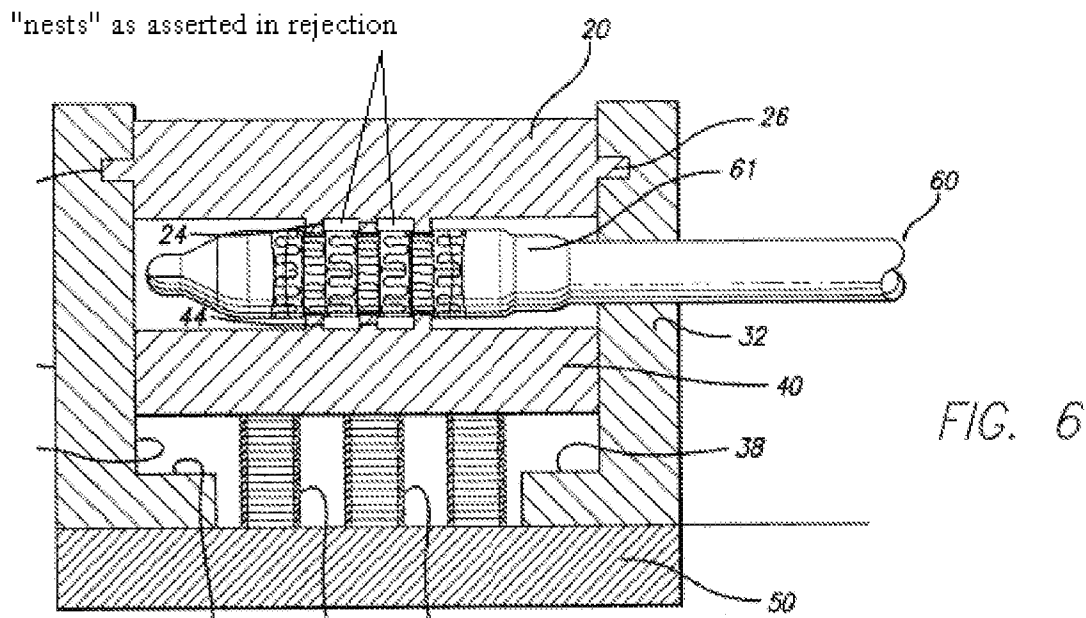
Nests and Marker

Claim 1 recites, “the first plate having a first nest to accommodate at least a

portion of the first cylindrical member, the second plate having a second nest to accommodate at least a portion of the second cylindrical member.” Claims 20 and 21 each recite, “the first plate having a first nest to accommodate at least a portion of the catheter, the second plate having a second nest to accommodate at least a portion of the marker.”

The Examiner asserts that Ching discloses “nests” as the spaces between the ribs 24, 44. See marked Figure 2 provided in Final Office Action at page 6.

A person of ordinary skill in the art would recognize that the “nests” as defined in the rejection cannot accommodate a portion of the Ching catheter, as would be required to meet the limitations of claims 1, 20 or 21. In the Ching device, the lowermost surfaces of ribs 24 and the uppermost surfaces of ribs 44 contact the Ching stent and function to crimp the stent onto the catheter. See e.g. Figure 6, provided below marked to show “nests” as asserted in the rejection.



Although portions of the Ching stent could extend into the Ching “nests” as defined in the rejection, a person of ordinary skill in the art would recognize that no portion of the catheter would ever become oriented with a Ching “nest.” Thus, Ching does not disclose or suggest a “first nest” to accommodate at least a portion of the first cylindrical member and a “second nest” to accommodate at least a portion of the second cylindrical member, as recited in claim 1; or a “first nest” to accommodate at least a portion of the catheter and a “second nest” to accommodate at least a portion of the second cylindrical member to accommodate at least a

portion of the marker, as recited in claims 20 and 21.

Applicants further assert that Ching does not teach a “marker” as recited in independent claims 20 and 21. Therefore, Applicants assert that Ching does not disclose or suggest all of the limitations of the pending claims.

Claim Rejections Under 35 USC § 103

The rejection admits that Ching does not disclose the limitations recited in the rejected claims, but then asserts “it would have been an obvious matter of design choice to modify Ching to obtain the invention as specified in claims 6, 12 and 23.” See Final Office Action at pages 6-7.

The rejection does not provide any prior art references, or assert any prior art teaching, that would motivate a person of ordinary skill in the art to modify Ching. Thus, the rejection ignores a lack of direction from the prior art.

Due to the lack of prior art, the rejection fails to present any of the three basic criteria required to establish a *prima facie* case of obviousness. Applicants request withdrawal of the rejections under 35 USC § 103. See also Response After Final filed 8/17/07 at pages 9-10.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: October 18, 2007

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